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Steven Dale Goodman

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Robert A. Voigt, Jr.

WINSTEAD SECHREST & MINICK PC

PO BOX 50784

DALLAS, TX 75201

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN DALE GOODMAN, JAMES PATRICK HOFF,
RANDALL SCOTT SPRINGFIELD, and JAMES PETER WARD

Appeal 2008-0076
Application 09/931,629
Technology Center 2100

Decided: October 9, 2008

Before LANCE LEONARD BARRY, CAROLYN D. THOMAS, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-4 and 6-10. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method for updating a program in a data processing system comprising the steps of:

requesting a trusted platform module ("TPM") to perform a signature verification of an update to the program;

the TPM performing the signature verification of the update to the program;

if the signature verification of the update to the program is successful, using the TPM for unlocking a memory unit storing the program; and

modifying the program with the update to the program in response to the unlocking of the memory unit storing the program.

B. REJECTIONS

Claims 1, 4, and 8 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 (and claim 3) of copending Application No. 09/931,550.

Claims 1-4 and 6-10 stand rejected 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,188,602 ("Alexander") and U.S. Patent No. 6,678,833 ("Grawrock").

"Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween." *Ex parte Katsukawa*, No. 2007-0732, 2007 WL 3043602 at *2 (BPAI 2007).

II. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

The "Applicants respectfully traverse this rejection . . . since the co-pending application is merely pending, Appellants will address this double patenting rejection when either such co-pending application issues or claims 1, 4 and 8 are allowed in this Application." (Supp. App. Br. 4.) Therefore, the issue is whether the Appellants have shown error in the Examiner's provisional rejection.

Claims may be provisionally rejected for obviousness-type double patenting over claims in a commonly assigned, copending patent application. *In re Wetterau*, 356 F.2d 556, 557-58 (CCPA 1966). This is true even if the claims in the copending application stand rejected. *Ex parte Karol*, 8 USPQ2d 1771, 1773 (Bd. Pat. App. & Int. 1988).

Here, the provisional rejection over claims 3 and 18 of copending Application No. 09/931,550 does not fail merely because the claims are not yet patented. The Appellants have shown no error in the rejection. Therefore, we affirm the provisional rejection of claims 1, 4, and 8 under the judicially created doctrine of obviousness-type double patenting.

III. OBVIOUSNESS REJECTION

The Examiner admits that "Alexander fails to teach the use of a trusted platform module ('TPM') to perform a signature verification of an update to the program." (Answer 3.) "[T]he reliance of the signature verification performed at TPM on the BIOS image is laid upon the Grawrock reference (Grawrock: Column 4 Line 1 - 18))" (*Id.* 4.) The Appellants argue that in the latter reference "[t]here is no signature verification of an update to a program." (Supp. App. Br. 6.) Therefore, the issue is whether the Examiner has shown that Grawrock uses a TPM to perform signature verification of an update to a program.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, the part of Grawrock relied on by the Examiner explains that "the TPM 230 provides TPM services such as a digital signature featuring the boot block identifier 330, keying material, certificates and the like."

(Col. 4, ll. 15-18.) The Examiner has not persuaded us that providing a digital signature constitutes performing signature verification, let alone performing signature verification of an update to a program.

Absent a teaching or suggestion of using uses a TPM to perform signature verification of an update to a program, we are unpersuaded of a prima facie case of obviousness. Therefore, we reverse the rejection of claims 1-4 and 6-10 under § 103(a).

IV. CONCLUSION

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the Supplemental Appeal Brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

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No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

rwk

Robert A. Voigt, Jr.
WINSTEAD SECHREST & MINICK PC
PO BOX 50784
DALLAS TX 75201